

Application No. 09/740,345
Applicant: Minoru Mukaida
Response

REMARKS

This is in response to the official action dated March 1, 2004. Reconsideration is respectfully requested.

Claim 28 has been amended to state that the article is tire or shoe sole. Support is found in paragraph 1 of the application.

Claims 28-30 and 34-38 stand rejected as being anticipated by Yoshimura. Yoshimura relates to a magnetic recording medium as a substrate, and does not teach coating a surface of an article being a tire or shoe sole (per applicant's amended claims). As anticipation requires that each and every element be taught in the cited reference, Yoshimura can not anticipate claim 28 and its dependent claims. Therefore, the rejection should be withdrawn.

Claims 28-38 stand rejected as being obvious over Craven in view of *Polymer Science*. The examiner notes that applicant has provided evidence that applicant's particular coating may show unexpected results, but failed to consider this based on a position that the claims were not commensurate in scope with the teaching. Applicant has now amended claim 28 to state that the article is a rubber tire or shoe sole, following the data of the specification. Accordingly, applicant incorporates the arguments made in the response filed July 30, 2003, and submits that the presently claimed invention demonstrates surprisingly good results compared to the prior art, and therefore is not obvious. The rejection should be withdrawn.

As to the examiner's argument that the 'comprising' language relating to the antislipping agent is not sufficiently limiting, applicant respectfully disagrees. The examiner suggests substituting 'containing' for 'comprising', but it is noted that this is equivalent under the patent

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law, and does not further limit the scope of the claim (see MPEP 2111.03). The claim requires that the film comprise an antislipping agent. The antislipping agent, thus present, must 'consist of' particles having a certain diameter. It is not seen how this language allows for antislipping agent particles which are not within this diameter. The 'comprising' allows for *other* elements to be present in the film, but if other *antislipping agent particles* are present, would they not be limited by the 'consisting of' language as to the diameter? An interpretation that the film must 'consist' of antislipping agent particles is unduly limiting, as it could be read to exclude any other components, unrelated to antislipping agent particles.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Response (6 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: May 14, 2004

By 

Tina Manor